REMARKS

Applicants bring attention to pending U.S. Patent Application Serial No. 10/592,257 filed on September 8, 2006, and titled "Liquid Container." The instant application and Applicants Serial No. 10/592,257 are both assigned to Santen Pharmaceutical Co., Ltd.

Claims 7-16 are in the application and are rejected. This Amendment amends claims 7-16 to more positively recite Applicants' patentably novel eye drop container, and adds new claims 18-25 to recite Applicants' patentably novel eye drop container in varying scope. Support for the amendments to claims 7-16 is found in paragraph [0006] of the application. Based on the forgoing, Applicants respectfully request admission of the amendments to, and consideration of, claims 7-16

Claims 7-10, 13 and 14 are rejected under 35 U.S.C. §102(e) as being anticipated by Tsai, U.S. Patent No. 7,150,376 (hereinafter also referred to as "Tsai"). Applicants respectfully traverse the rejection of claims 7-10, 13, and 14 under 35 U.S.C. §102(e) as being anticipated by Tsai and request reconsideration thereof.

The eye drop container according to claims 7-10, 13, and 14 is characterized in that the container "comprises a container body having a liquid storage portion for containing liquid therein; and an instilling portion for allowing the liquid to flow out in an opened stage; wherein the container body includes an aerating device provided at the bottom thereof and having a filter element and a check valve for allowing ambient air to flow in from the outside and preventing the liquid from flowing out."

The Office Action interprets the "inner–layered pocket 13 of Tsai as the liquid storage portion; the end opening section 11" as the instilling portion, the "netted hole layer 18" as the filter element, and the "lower diaphragm 16" as the check valve, respectively. Applicants respectfully disagree with the interpretation of the Office Action. More particularly, as the outer side of the inner-layered pocket 13 is covered with the "outer-layered enclosure 13", ambient air through the lower diaphragm 16 cannot enter the inner-layered pocket 13 as the liquid storage portion.

Further, Applicants respectfully submit that the Office Action erroneously interprets the "netted hole layer 181" as corresponding to the "filter element" recited in claim 7. Tsai, in column 3, lines 20-29, discloses that the "lower diaphragm 16", taken as the check valve by the Office Action, functions similarly to the "upper diaphragm 15." That is, the upper diaphragm 15 is movable between the netted hole layer 171 and the outlet layer 172 and, when it comes into tight contact with the outer layer 172, the hole of this layer 172 is closed, thus functioning as a valve. In particular, the netted hole layer 171 acts as a member for checking movement of the upper diaphragm 15 in its opening direction. Similarly, the lower diaphragm 16 is movable between the netted hole layer 181 and the inlet hole layer 182, thus acting as a valve. Therefore, the netted hole layer 181 acts as a member for checking movement of the lower diaphragm 16 in its opening direction. As such, there is no disclosure at all in Tsai that the netted hole layer 181 has any filter function.

Moreover, with the container of Tsai, ambient air introduced through the lower diaphragm 16 is not allowed to enter the inner-layered pocket 13, which is a liquid storage portion. As such, there occurs no contact between the liquid stored in the liquid storage portion and this ambient air. Therefore, as there is no risk of this liquid being contaminated with the ambient air, there exists, no teaching of the netted hole layer 181 being taken as a "filter."

Further, the liquid storage container of the present invention is intended for "preventing the interior of a liquid storage portion from being contaminated by germs or the like when ambient air is drawn in" (paragraph [0017] of the instant application). As mentioned above, the object of the container of Tsai is to be able to "prohibit air form entering the container to oxidize the contents of the container (column 2, lines 3-5 of Tsai). Hence, as the liquid stored in the liquid storing portion does not contact the ambient air, there is no risk of this liquid being contaminated by the ambient air. Therefore, the disclosure of Tsai could not have motivated one skilled in the art to obtain the container of the present invention from the disclosure of Tsai. Consequently, the liquid storage container of the present invention, characterized by a filter element provided at the bottom face of the container body, is not disclosed by Tsai.

For the reasons set forth above, Applicants respectfully submit that the present invention recited in claims 7-10, 13, and 14 is patentably different in its construction from the container of Tsai because, for among other reasons, the container of Tsai does not have any filter at the bottom face of the container body. Based on the forgoing, Applicants respectfully request withdrawal of the rejection of claims 7-10, 13, and 14 under 35 U.S.C. §102(e) as being anticipated by Tsai.

Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai. The Office Action alleges that Tsai discloses a liquid storage container with a bottom cap 182 substantially, as claimed, and states that Tsai does not disclose the cap to be separable. The Office Action continues by alleging that it would have been obvious to one of ordinary skill in the art to make the cap 182 of Tsai separable in order to allow replacement of and cleaning of the valve 16 and the filter 181.

Applicants respectfully traverse the rejection of claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Tsai and request reconsideration thereof. Claim 11 is dependent on claim 7, through claim 9, and claim 12 is dependent on claim 7, through claims 8 and 10. Claims 7-10 and Tsai were discussed above, and in the above discussion, Applicants identified patentable differences between Applicants' claims 7-10 and Tsai.

Claims 11 and 12 recite, in one form or another, a bottom cap for covering the aerating device. The Office Action erroneously takes the inlet hole layer 182 of Tsai as the cap. As a matter of fact, as discussed above, the lower diaphragm 16 is movable between the netted hole layer 181 and the inlet hole layer 182, thus acting as a valve to close the hole of the inlet hole layer 182. In this way, it can be understood that the inlet hole layer 182 is an element constituting the valve together with the lower diaphragm 16. Further, the inlet hole layer 182 forms a hole.

As described above, the inlet hole layer 182, which constitutes a portion of the valve and forms a hole cannot be expected to achieve the advantageous effect provided by the bottom cap recited in claims 11 and 12. From the forgoing discussion, the feature of the present invention that the bottom cap covering the aerating device at the bottom of the

container body is separable from the container body is not obvious from the disclosure of Tsai.

Based on the forgoing, Applicants respectfully request withdrawal of the rejection of claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Tsai.

Claims 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai, in view of Japanese 6-15636 (hereinafter also referred to as "Japanese '636"). The Office Action alleges that Tsai discloses a liquid storage container, substantially as claimed, and states that Tsai does not disclose an upper seal and a cap for opening the upper seal. The Office Action continues by alleging that Japanese '636 teaches another liquid storage container having an upper seal 22 and a cap 28 that opens the upper seal for the purpose of ensuring against contamination of the liquid. The Office Action concludes by alleging that, it would have been obvious to one of ordinary skill in the art, to provide the container of Tsai with an upper seal and a cap for opening the seal as, for example, taught by Japanese '636 in order to endure against contamination of the liquid.

Applicants respectfully traverse the rejection claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Tsai in view of Japanese '636 and request reconsideration thereof. Claim 15 is dependent on claim 7, and claim 16 is dependent on claim 7, through claim 8. Claims 7 and 8, and Tsai were discussed above. Japanese '636 discloses an ophthalmic container having a needle-like convex portion 38 used as an opening means for penetrating a closure portion 22.

The Office Action alleges that Japanese '636 discloses an upper seal (closing portion) 22 and a cap (inner plug) 28 provided for ensuring prevention of contamination of the liquid. In the case of the container of Japanese '636, a needle-like convex portion 38 is used for penetrating the closing portion 22. However, after this penetration, opening/closing of the container is affected by attachment/detachment of the cap 46 to/from the inner plug 28. Therefore, the container of Japanese '636 lacks the characterizing construction of Applicants' invention recited in claims 15 and 16, namely, "a cap...including...a valve member for allowing the liquid to flow out and preventing ambient air from flowing into the chamber."

Therefore, the feature of providing a cap including a valve member is not obvious from the disclosures of Tsai and Japanese '636.

Claims 7, 8, 13, and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese 1-110147 (hereinafter also referred to as Japanese '147 and Tsai. The Office Action alleges that Japanese '147 discloses a liquid storage container including a body 1, a storage portion 5, an instilling portion 22, 24, and an aerating device with a bottom check valve 32, 34 substantially, as claimed, and states that Japanese '147 does not disclose a filter. The Office Action continues by alleging that Tsai teaches another liquid storage container having a bottom aerating device that is provided with a filter 181 for the purpose of ensuring against contamination of the liquid. The Office Action concludes by alleging that it would have been obvious to one of ordinary skill in the art to provide the container of Japanese '147 with an aeration filter as, for example, taught by Tsai, in order to ensure against contamination of the liquid.

Applicants respectfully traverse the rejection of claims 7, 8, 13, and 14 under 35 U.S.C. §103(a) as being unpatentable over Japanese '147 and request reconsideration thereof. Claims 7, 8, 13, and 14, and Tsai were discussed above. Japanese '147 discloses an instillation container. In this container, it is described that as a duck-bill type valve, there is provided an air inlet 32 having a streak of cut groove 34 which is normally closed tightly. As this container is placed with its bottom oriented upward, the mode of this placement is opposite to that of claims 7, 8, 13, and 14.

The Office Action alleges that the constructions of claims 7-10, 13, and 14 would have been obvious from the instillation container of Japanese '147 lacking a filter and the construction of the container of Japanese '147 having a filter 181. As discussed above, the container of Tsai precludes contact between the liquid stored in the liquid storing portion and ambient air. Whereas, the container of Japanese '147 is designed to allow introduction of ambient air directly into the liquid storing portion. Since the object of the container of Tsai is to be able to "prohibit air from entering the container to oxidize the contents in the container", one skilled in the art would not have been motivated to combine Japanese '147,

which introduces ambient air with the disclosure of Tsai, which prohibits air from entering the container.

If Japanese '147 and Tsai should be combined, this combination could not have arrived at the container having a check valve and a filter at the bottom, since the netted hole layer 181 used in Tsai does not have any filter function, as explained above.

Based on the forgoing, Applicants respectfully request withdrawal of the rejection of claims 7, 8, 13, and 14 under 35 U.S.C. §103(a) as being unpatentable over Japanese '147 and Tsai.

Claims 7-12 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Oh, U.S. Patent No. 6,003,734 (hereinafter also referred to as "Oh"), in view of Moon, et al., U.S. Patent No. 6,648,180 (hereinafter also referred to as "Moon"). The Office Action alleges that Oh discloses a liquid storage container including a body 34, a storage portion W, an instillation potion 12, an aerating device 30a with a filter 32b, as shown in Figure 3 and disclosed in column 4, lines 61-63, and a separable cap 30 substantially, as claimed, and states that Oh does not disclose a check value. The Office Action continues by alleging that Moon teaches another liquid storage container having a bottom aerating device 90 that is provided with both a filter and a check valve 94 for the purpose of ensuring against liquid leakage. The Office Action concludes by alleging that it would have been obvious to one of ordinary skill in the art to provide the serration device of Oh with a check valve as, for example, taught by Moon, in order to ensure against liquid leakage.

Applicants respectfully traverse the rejection of claims 7-12 under 35 U.S.C. §103(a) as being unpatentable over Oh, in view of Moon, and request reconsideration thereof. Claims 7-12 were discussed above. Oh discloses a "duplex stopper-type water dispensing and water bottle supporting apparatus." It is disclosed that an "air filtering apparatus 90" as the aerating device, a "check valve 94" as a valve and a "casing 93" as a cap are provided, respectively. Moon discloses a "water dispenser of refrigerator." It is described that a "lid 30", as a separable cap, a "valve means 36", as a valve, and an "air hole 30a", as an aerating means are provided, respectively.

Both Oh and Moon relate to an automatic dispenser for drinking water or the like. Whereas, the liquid storage container of the invention is an eye drop container to be pinched/squeezed by a human with his/her fingers, being vastly different in terms of size, construction, liquid dispensing method, etc. thus being technically different entirely. Therefore, one skilled in the art could not have referred to the disclosure contents of Oh and Moon in constructing an eye drop container.

Based on the forgoing, Applicants respectfully request withdrawal of the rejection of claims 7-12 under 35 U.S.C. §103(a) as being unpatentable over Oh, in view of Moon, and request allowance of claims 7-16.

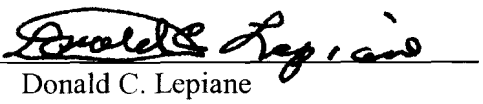
Applicants, by this Amendment, have added new claims 17-25. Support for new claims 17-25 is found, among other places, in the pending claims. The arguments put forth to patentably distinguish claims 7-16 over the art are applicable, among others, to patentably distinguish claims 17-25 over similar art.

Based on the forgoing, Applicants respectfully request admission of, consideration of, and allowance of, claims 17-25.

This Amendment represents a sincere effort to place this application in condition for allowance. In the event issues remain, the Examiner is invited to call the undersigned to discuss those issues before further action on this application is taken.

Respectfully submitted,

THE WEBB LAW FIRM

By 

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